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S/N: 10/711,603

REMARKS

In the Office Action mailed February 6, 2006, the Examiner identified three alleged "species" in the pending application. The Examiner classified "the species of Group A consisting of the embodiment as described in paragraph 13 of the specification, Group B consisting of the embodiment as described in paragraph 14 of the specification, and Group C consisting of the embodiment as described in paragraph 15 of the specification." The Examiner required Applicant to elect a single species for prosecution on the merits.

In a timely response mailed March 8, 2006, Applicant elected, with traverse, what the Examiner characterized as species A. Despite Applicant's arguments, the Examiner made the Restriction final, and withdrew claims 14-38 from consideration in the Office Action mailed April 4, 2006.

In the original Restriction of February 6, 2006 the Examiner made no arguments in support of the statement that the claims were patentably distinct species. Instead, the Examiner merely stated that claims directed to patentably distinct species were "a) the embodiment as described in paragraph 13 of the specification; b) the embodiment as described in paragraph 14 of the specification; and c) the embodiment as described in paragraph 15 of the specification."

Responsive thereto, Applicant argued that the Examiner has not identified any "species" and the subject matter of each paragraph identified by the Examiner corresponds to a respective independent claim. That is, the Examiner identified Group A and cited paragraph 13 as illustrating such. Similarly, with respect to Group B, the Examiner cited paragraph 14 in support of the identification of species. Additionally, with respect to Group C, the Examiner cited paragraph 15 in support of the identification of species. The Examiner simply attempted to identify species based on claim elements of the independent claims. Applicant further argued that one will readily recognize that the subject matter of paragraph 13 corresponds to the elements of claim 1, the subject matter of paragraph 14 corresponds to the elements of claim 14, and the subject matter of paragraph 15 corresponds to the elements of claim 28. These paragraphs merely summarize the invention as claimed. The identification of alleged species based on claim elements of the independent claims is clearly improper.

Applicant went on to argue that MPEP §806.04(e) clearly sets forth that the Examiner's species restriction is improper because "[c]laims are definitions of inventions" and "[c]laims are never species." *MPEP §806.04(e)*, (emphasis in original). The Examiner attempted to circumvent the rule by citing to portions of the specification—which is nothing more than form over substance when the specification contains paragraphs that merely correspond to independent claims. Therefore, the Examiner effectively attempted to proffer a species election based solely on the claims. *See Id.* The Examiner cannot attempt to identify species based simply on the fact that there are multiple independent claims. The Examiner's attempt to sidestep the requirements of MPEP §806.04(e) is improper, and therefore, the restriction is not

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sustainable. The Examiner did not present any proper grounds for a species restriction and has not provided any support for a species restriction.

In the Response of March 8, 2006, Applicant argued that the restriction must be withdrawn and the claims rejoined. In the Office Action of April 4, 2006, the Examiner responded, stating that Applicant's arguments were:

not found persuasive because applicant's argument that the species have not been identified they somehow, correspond to the claims, is immaterial to the question of the propriety of the restriction requirement. Moreover, MPEP §809.02(a) directs the examiner to identify the species, preferably with figure drawings, or examples. The figure drawings in the instant case, are useless for this purpose, so the specification has been used. Applicant' (sic) should regard as a fortunate coincidence that the correspondence between the claims and the paragraphs of the specification is so close. This means that the species can be clearly identified and the claims readable thereon elected without confusion or discrepancy. The identified species are patentably distinct on their face as they do not have overlapping scope.

The reason that the figures are "useless for this purpose" is that there are no restrictable species. The three paragraphs cited by the Examiner as disclosing distinct "species" of the present invention are found in the Brief Description of the Invention and further illustrated in the Detailed Description of the Preferred Embodiment section of the Specification, each Embodiment allegedly a separate species. However, even a cursory comparison of the cited paragraphs to the three independent claims of the present Application quickly elucidates that the language of paragraphs 13, 14, and 15 is substantially identical to that of one of the three independent claims. More specifically, paragraph 13 (Species A) corresponds to claim 1, paragraph 14 (Species B) corresponds to claim 14, and paragraph 15 (Species C) corresponds to claim 28. Thus, the Examiner has effectively restricted claims as species and has not identified actual embodiments of the alleged species. Section 806.04(e) of the MPEP is very clear in stating that "*[c]laims are never species.... Species are always the specifically different embodiments.*" (Emphasis in original). Therefore, the present restriction attempts to circumvent this mandate by restricting between paragraphs of the Application which are paragraph-form summaries of the independent claims. Such a manner of restriction is improper, unsustainable, and must be withdrawn.

In addition, the Examiner has not clearly identified the "species" and has not stated any characteristics which distinguish between these "species." See MPEP §809.02(a) (the Examiner must "[c]learly identify each... of the disclosed species *to which claims are restricted*. The species are preferably identified as... figures... or... examples") *Id.* Furthermore, in the absence of distinct figures or examples to identify the several species, the mechanical means, the particular material, or other distinguishing characteristic of the species should be stated for each species identified. *Id.* An inspection of the cited claims and the Detailed Description of the Preferred Embodiment reveals that the purported

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"species" are substantially interrelated. Thus, the Examiner could not provide a precise identification of the "species" or explain any distinguishable characteristics as between the cited claims. Instead, the Examiner merely stated that the figure drawings are "useless for this purpose" and that the Applicant should regard as a "fortunate coincidence that the correspondence between claims and the paragraphs is so close." Applicant submits that it is no "fortunate coincidence" of correspondence between claims and the cited paragraphs. Rather, the paragraphs cited merely summarize the claims. The subject matter of the claims and their corresponding paragraphs do not support patentably distinct "species."

In sum, the Examiner has not provided a valid basis for restriction between Groups A, B, and C. The Examiner has not stated any characteristics which distinguish between these "species." The present restriction is improper since it effectively restricts claims and not embodiments. This failure to identify distinguishable characteristics indicates that the restriction required by the Examiner cannot be substantively supported.

For at least these reasons, Applicant respectfully requests that the restriction be withdrawn. Accordingly, Applicant respectfully requests rejoinder of all claims.

Applicant believes no fee is due for filing the Petition. However, should a fee be deemed necessary, Applicant hereby authorizes charging of Deposit Account No. 07-0845.

Respectfully submitted,

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